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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,968	03/08/2004	Kurt A. Habecker	3600-198-02	8631

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EXAMINER	
JENKINS, DANIEL J	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/795,968	HABECKER ET AL.	
	Examiner	Art Unit	
	Daniel J. Jenkins	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/6/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 36-43, 48, 49, 50, 51, 53, 54, 55, 56, 58, 59, 60 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang US Pat. No. 5,448,4447 (Chang).

Chang discloses a flaked niobium powder at col. 4, lines 11-18.

Chang further discloses wherein the niobium powder is nitrogen doped at amounts of 1850 to 2550 ppm (col. 5, lines 17-22).

Chang further discloses wherein the niobioum powder is agglomerated (col. 4, lins 19-28).

The limitations of claims 36-42, 48, 49 which are directed to the characteristics of the powder post-sintering are not given weight to the claims.

Claims 53 and 54 are directed at the powder flow rate, which is inherently met by the flake morphology as disclosed by Chang unless a showing is provided to overcome this assertion.

Claims 55 and 56 are directed to the density of the powder, which the Examiner finds to be inherently met by a powder produced by a process of similar processing conditions unless a showing is provided to overcome this assertion.

Claim 58 is directed to an aspect ration limitation which is inherently met by a flake morphology powder produced by similar processing conditions unless a showing is provided to overcome this assertion.

Claim 61 is found as a combination of limitations discussed above.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang. Chang discloses the invention substantially as claimed (see paragraph 2 above). However, Chang is silent as to the range of nitrogen doping,

6. Claims 57 and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang.

Chang discloses the invention substantially as claimed (see paragraph 2 above). However, Chang is silent as to the range of particle size, but discloses particle size of less than -40 mesh and gives an example of unagglomerated powder of 1 um (see Example 8).

It would have been obvious to one having ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility. Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP 2144.05.

7. The Examiner notes that claims 44-47, directed to BET limitations, is not met by the disclosure of Chang, which discloses BET of between about 0.25 and 0.55 (see Chang claim 31).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 36-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 19, 20, 34 and 36 of U.S. Patent No. 6,051,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims subject matter completely encompasses the pending claimed material.

10. Claims 36-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10-18, 27-29, 45-48, 52-57, 63-67, 77-103 and 121 of U.S. Patent No. 6,165,623. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims subject matter completely encompasses the pending claimed material.

11. Claims 36-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 13-17, 20-23 and 36-53 of U.S. Patent No. 6,375,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims subject matter completely encompasses the pending claimed material.

12. Claims 36-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-38 of U.S. Patent No. 6,420,043. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims subject matter completely encompasses the pending claimed material.

13. Claims 36-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 42-43 and 46-63 of U.S. Patent No. 6,702,869. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims subject matter completely encompasses the pending claimed material.

14. Claims 36-64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-30 and 44-62 of copending Application No. 10/770,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is common knowledge to limit the amount of contaminant materials in the powder.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 36-64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18, 22 and 30-

37 of copending Application No. 10/770,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claimed subject matter completely encompasses the pending claimed material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Jenkins whose telephone number is 571-272-1242. The examiner can normally be reached on M-TH6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1242. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel J. Jenkins
Primary Examiner
Art Unit 1742

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